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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,866	10/03/2006	Alexander A. Khromykh	252007	2237

23460 7590 11/03/2010  
LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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BOESEN, AGNIESZKA

ART UNIT	PAPER NUMBER
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1648

NOTIFICATION DATE	DELIVERY MODE
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11/03/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com

# Office Action Summary

**Application No.**

10/577,866

**Applicant(s)**

KHROMYKH ET AL.

**Examiner**

AGNIESZKA BOESEN

**Art Unit**

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-25-29, 38, 39, 41-64 is/are pending in the application.
- 4a) Of the above claim(s) 54-57 and 61-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22, 25-29, 38, 39, 41-53 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/28/2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The Amendment filed August 25, 2010 in response to the Office Action of February 25, 2010 is acknowledged and has been entered. Claims 17 and 38 have been amended. Claims 54-57 and 61-64 are withdrawn. Claims 17-22, 25-29, 38-39, 41-53, and 58-60 are under examination in this Office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Rejection of Claims 17-22, 25-29, 38, 39, 41-53 and 58-60 under 35 U.S.C. 102(e) or in the alternative 102(a) as being anticipated by Khromykh (WO2003/046189 A1 in IDS on 10/3/2006) **is maintained.**

Applicant's arguments have been fully considered but fail to persuade. Applicant amended the claims to recite the method step regarding eliciting a protective immune response to a West Nile virus, in the animal claim 17 and inducing an immune response to at least another flavivirus in the animal claim 38. Applicant argues that Khromykh is silent on whether an isolated nucleic acid encoding Kunjin virus is useful for eliciting protective immune response to at least another flavivirus, much less West Nile virus.

In response the Examiner notes that the step b) in claim 17 and 38 merely recites the intended result which occurs due to administering an isolated nucleic acid encoding an infectious attenuated Kunjin virus. Because the prior art teaches administering an isolated nucleic acid encoding an infectious attenuated Kunjin virus to an animal, the prior art method necessarily elicits a protective immune response to a West Nile virus and elicits an immune response to another flavivirus. The fact that Applicant has recognized another advantage cannot be basis for patentability when the prior art composition necessarily possesses the recited properties i.e. elicits a protective immune response to a West Nile virus and elicits an immune response to another flavivirus.

(MPEP 2145) The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also *Lantech Inc. v. Kaufman Co. of Ohio Inc.*, 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) ("The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.").

Because Khromykh discloses the method step of the present invention Khromykh anticipates the present invention and therefore the rejection is maintained.

Rejection of Claims 17, 18, 20-22 and 25 under 35 U.S.C. 102(b) as being anticipated by Khromykh et al. (Journal of Virology, 2001, Vol. 75, p. 4633-4640) is **withdrawn** in view of Applicant's arguments and amendment.

***Claim Rejections - 35 USC § 103***

Rejection of Claims 17-22, 25-29, 38, 39, 41-53 and 58-60 under 35 U.S.C. 103(a) as being unpatentable over Khromykh et al. (Journal of Virology, 2001, Vol. 75, p. 4633-4640) in view of Hall et al. (Virology, 1999, Vol. 264, p. 66-75) **is withdrawn** in view of Applicant's arguments and amendment.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AGNIESZKA BOESEN whose telephone number is (571)272-8035. The examiner can normally be reached on 9:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zachariah Lucas can be reached on 571-272-0905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Agnieszka Boesen/  
Examiner, Art Unit 1648

/Stacy B Chen/  
Primary Examiner, Art Unit 1648